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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,787	12/11/2000	Masayuki Kondo	Q62188	2734

7590 05/05/2004
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

FIGUEROA, FELIX O

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 05/05/2004

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 20040421

Application Number: 09/732,787
Filing Date: December 11, 2000
Appellant(s): KONDO, MASAYUKI

Diallo T. Crenshaw
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 20, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because Appellant has fail to provide reasons as why claims 6 and 8 do not stand or fall together with claim 4 and 7, as set forth in 37 CFR 1.192(c)(7) and (c)(8). Further, the Brief merely recites that "claims 6 and 8 are patentable at least by virtue of their dependency from claim 4", and the Appellant has

not presented any separate arguments to distinguish the claims from the prior art of record. Accordingly, claims 4 and 6-8 will be treated as a single group.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

US 5,885,108	Gerrans, Jr.	03-1999
US 4,969,845	Hauchard et al.	11-1990

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (APA) in Fig.6 in view of Gerrans, Jr. (US 5,885,108).

Applicant's admitted prior art discloses substantially the claimed invention except for the continuously reduced portion. Gerrans teaches a molded portion (16) wherein a circumferential size of the molded portion from a part corresponding to the terminal connecting portions is continuously reduced, so that the rear end portion has a same diameter as the cable (22), and wherein there is no increase in the circumferential size of the molded portion in a direction parallel to a direction in which the terminal fittings extend in order to provide a smoother gripping on the molded portion. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the molded portion of the APA being continuously reduced, as taught by Gerrans, to provide a smoother gripping on the molded portion.

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's APA in Fig.6 in view of Gerrans, and further in view of Hauchard et al. (US 4,969,845).

Applicant's APA, as modified by Gerrans, discloses substantially the claimed invention except for the plurality of parallel alternate concave grooves and convex ribs. Hauchard teaches a plurality of parallel alternate concave grooves and convex ribs (37) formed in a direction parallel to a direction that the wire (14) extends, and arranged side by side in a second direction perpendicular to the first direction, to save material while providing structural strength to the molded portion. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the molded portion having a plurality of parallel alternate concave grooves and convex ribs formed in a direction parallel to a direction that the wire extends, as taught by Hauchard, to save material while providing sufficient structural strength to the molded portion.

(11) Response to Argument

In response to Appellant's argument (in page 5, first full paragraph) that Gerrans does not teach or suggest that the molded portion provides a smoother gripping, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been evident to one skill in the art that a contoured shape, as taught by Gerrans, provides a smoother gripping by avoiding substantially sharp or pointy edges that may be uncomfortable to a user's hand.

In response to Appellant's arguments that "nowhere does Gerrans discuss something or someone holding or gripping the outer covering 16 of Gerrans", it is noted that all removable connectors (for example, as shown by Gerrans and the APA) are required to be manipulated / handled by either someone or something to perform / complete an electrical connection.

In response to Appellant's arguments (in the second full paragraph of page 5) that "it is not clear how the alleged smoother gripping outer covering 16 of Gerrans would have been incorporated into the APA", please note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Please note that Gerrans's use of a smooth over-molded portion shows the desirability for a smooth over-molded portion.

In response to Appellant's arguments (in page 6, first full paragraph) that Gerrans does not teach or suggest that "the shape of the alleged molded portion is 'contoured', and that there is no support for labeling the molded portion as such", it is noted that

neither the rejection nor the Response to Arguments on the Office action dated August 22, 2003 state that the molded portion is "contoured". Rather, it has been stated that the smoother gripping is provided by avoiding sharp or pointy edges.

In response to Appellant's arguments that "just because the alleged contour shaped molded portion does not appear to show sharp or pointy edges, it does not necessarily follow that the molded portion would provide smoother gripping" because "a molded portion that does not have sharp or pointy edges could, in fact, not provide smoother gripping based on several other factors, including the texture, size, length, etc., of the molded portion", it is noted that while many factors can be related to a smooth gripping, they are not at presently at issue. Further, *The American Heritage® Dictionary of the English Language, Fourth Edition* defines "smooth" as "[h]aving a surface free from irregularities, roughness, or projections" Copyright © 2000 by Houghton Mifflin Company. In this case, by avoiding irregularities, roughness and/or projections, Gerrans provides a smoother gripping surface.

In response to Appellant's arguments (starting in the last paragraph of page 6) that the present application does not disclose "where and/or how the APA structure would be gripped, or how it would benefit from the alleged smooth gripping molded portion of Gerrans", it is recognized some electrical connectors define specific holding / handling portions, such as contoured jackets or handles. Nonetheless, for connectors without a evident handling portion, the housing itself function as the holding portion. It is noted that based on the location of the housing (closest to the interface) and its relative rigidity (normally stiffer than the cable to which it is attached), the over-mold portion /

Art Unit: 2833

housing provides the stability required to align and guide the connector towards the mating connector.

Additionally, it is noted that the APA does not require a specific statement on how it would benefit from a specific improvement (in this case, a smoother gripping) in order to allow one of ordinary skill in the art to improve upon it.


For the above reasons, it is believed that the rejections should be sustained.

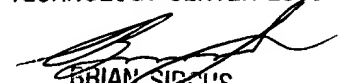
Respectfully submitted,

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April 22, 2004

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